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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,513	11/01/2005	Theodor Gerhard Rosch	169-85304	9097
22342 7590 06/09/2009 FITCH EVEN TABIN & FLANNERY 120 SOUTH LASALLE STREET SUITE 1600 CHICAGO, IL 60603-3406				
EXAMINER				
OU, JING RUI				
ART UNIT		PAPER NUMBER		
3773				
MAIL DATE		DELIVERY MODE		
06/09/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/531,513

Applicant(s)

ROSCH, THEODOR GERHARD

Examiner

JING OU

Art Unit

3773

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-34 is/are pending in the application.
- 4a) Of the above claim(s) 18-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 March 2009 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-856)
- _____ Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- _____ Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the amendment filed on 03/18/2009. Claims 18-34 are pending. Claims 18, 22, and 27 are independent. Claims 18-21 are withdrawn from consideration.

Specification

2. The amendment filed 03/16/2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Fig A and Fig B.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

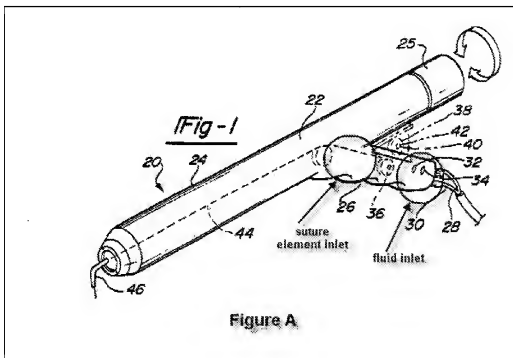
1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

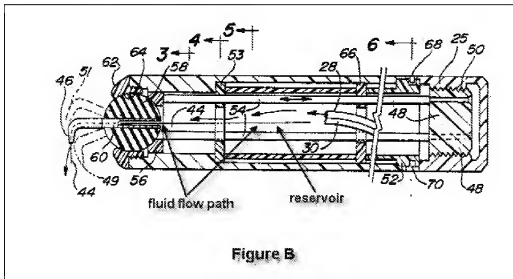
5. Claims 22-31 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yoon (US Pat. No.: 4,935,027).

In regard to Claims 22-31, Weng discloses a medical implement (20), which includes a body (24) defining: tissue penetration device (46); a fluid flow path (see Figure B below); a fluid inlet (see Figure A below); an outlet (distal opening of 46); a suture element inlet (see Figure A below) which opens into the fluid flow path at a position intermediate the fluid inlet and the outlet; wherein the body defines a suture element feed path which intersect the fluid flow path at a position intermediate the fluid inlet and the outlet, the suture element feed path opening into the fluid flow path via the suture element inlet, the suture element feed path having a suture element feed opening which opens out of the medical implement through which the suture can be fed from the outside the medical implement into the suture element feed path and into the fluid flow path (Fig. 1, When door 38 is open, the spool of suture material is located outside the medical implement and can be fed from the outside the medical implement into the suture element feed path and into the fluid flow path); wherein the body defines a reservoir (see Figure B below); the implement includes releasable securing device; and a tissue drive device (channel of 60); and wherein the fluid inlet and the suture element inlet are provided by a single inlet into the fluid flow path.

Weng does not appear to disclose the suture element feed path having a suture element feed opening which opens out of the medical implement through which the suture can be fed from the outside the medical implement into the suture element feed path and into the fluid flow path when the door 38 is closed. However, Yoon teaches

that the spool of the material is fed from outside the medical implement (Fig. 1). At the time of the invention was made, it would have been obvious to one of ordinary skill in the art to modify the device of Weng to have the spool of suture mounted outside the medical implement as taught by Yoon. The suggestion/motivation for doing so would have been to provide manually or automatically-operable provisions for advancing suture material from the supply reel (Yoon, Col.7, lines 60-62).





6. Claims 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weng (US Pat. No.: 5,569,270) in view of Yoon (US Pat. No.: 4,935,027) as applied to claim 27 above, and further in view of Mull (US Pat. No.: 2,611,366).

In regard to Claims 32-34, Weng in view of Yoon discloses all the limitations of the claims but fails to disclose a releasable securing device including a securing rod displaceable within a bore, wherein the securing rod is resiliently biased toward a rest position by a diaphragm over a bore opening.

However, Mull discloses a releasable securing device including a securing rod (60) displaceable within a bore (56), defined in the body at right angles to the suture element feed path and intersect the suture element feed path (53); wherein the securing rod is resiliently biased toward a rest position by a diaphragm (61) over a bore opening.

Weng, Yoon, and Mull are analogous art because they are from the same field of endeavor.

At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Weng, Yoon, and Mull before him or her, to modify the medical implement of Weng in view of Yoon to include a releasable securing device including a securing rod displaceable within a bore, defined in the body at right angles to the suture element feed path and intersecting the suture element feed path; wherein the securing rod is resiliently biased toward a rest position by a diaphragm over a bore opening as taught by Mull.

The motivation/suggestion for doing so would have been to control the release of the suture by fluidic pressure (Mull, Col. 4, lines 41-54).

Therefore, it would have been obvious to combine Mull with Weng and Yoon to obtain the invention as specified in the instant claims.

Response to Arguments

7. Applicant's arguments with respect to claims 22-34 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JING OU whose telephone number is (571)270-5036. The examiner can normally be reached on M-F 7:30am - 5:00pm, Alternative Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Uyen (Jackie) T Ho can be reached on (571)272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JO
/(Jackie) Tan-Uyen T. Ho/
Supervisory Patent Examiner, Art Unit 3773